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EXAMINER

HUNTSINGER, PETER K

ART UNIT	PAPER NUMBER
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2624

DATE MAILED: 08/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/960,162

Applicant(s)

WHISNANT, ET AL.

Examiner

Peter K. Huntsinger

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-86 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-86 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 September 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 3/11/02.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

### **DETAILED ACTION**

1. Claims 4, 15, 19, 21, 22, 25-28 are objected to because of the following informalities: On page 14, lines 32 and 33, "said instructions for directing said instruction further" should be replaced with "said instructions for directing further". On page 16, lines 21 and 22, "wherein said instructions wherein said instructions to" should be replaced with "wherein said instructions to". On page 17, lines 23 and 24, "responsive receiving said receiving said routing" should be replaced with "responsive to receiving said routing". On page 17, line 34, "processing unit to" should be replaced with "processing unit further comprise". On page 18, line 6, "processing unit to" should be replaced with "processing unit further comprise". Claims 25-28 should state "the system of claim 24" to fix the lack of an antecedent. On page 20, line 21, "processing unit to" should be replaced with "processing unit further comprise".

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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3. Claims 1-6, 15-32, 34-40, 43-49, 58-75, 77-83, and 86 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kurokawa et al. Publication US 2001/0049640 and Garfinkle et al. U.S. Patent 6,017,157.

Referring to claim 1, Kurokawa et al. disclose a system for transferring a digital image to a fulfillment center to generate a photographic product from said digital image comprising: Instructions for directing a first processing unit (Print service receiving server, of Fig. 1, page 1, paragraph 19) to: Maintain a list of at least one fulfillment centers available to generate a photograph from said digital image (Fig. 4, page 2, paragraph 28), Receive a request from a photographer for a list of options to generate said photographic product from said digital image (page 2, paragraph 23), Receive an order from said photographer (Step 48 of Fig. 2, page 2, paragraph 30), Transmit routing information to said photographer wherein said routing information is for transmitting said digital image to a one of said at least one fulfillment centers to process said order (page 2, paragraph 27), and Transmit said order to a fulfillment center processing unit of said one of said at least one fulfillment centers (page 2, paragraph 29). Kurokawa et al. do not disclose expressly a media readable by said first processing unit that stores said instructions. It is inherent that the server of Kurokawa et al. includes a memory that stores the instructions performed by the server. RAM is an essential component for any server and stores the instructions that are performed. Kurokawa et al. do not disclose expressly displaying said list of options. Garfinkle et al. disclose displaying a list of options for generating said photographic product (col. 8, lines 58-61). Kurokawa et al. and Garfinkle et al. are combinable because they are from

the same field of ordering digital photographs. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to display the list of options for generating a photographic product to a user. The motivation for doing so would have been to let the user select the options from a predetermined list so that the user knows what options are available. Therefore, it would have been obvious to combine Garfinkle et al. with Kurokawa et al. to obtain the invention as specified in claim 1.

Referring to claims 2 and 45, Kurokawa et al. disclose wherein said instructions further comprise: Instructions for directing said first processing unit to: Receive said digital image from said photographer (page 2, paragraph 22).

Referring to claims 3 and 46, Kurokawa et al. disclose wherein said instructions to process said order further comprise: Instructions for directing said first processing unit to: Transmit said digital image to said fulfillment center processing unit (Step 47 of Fig. 2, page 2, paragraph 28).

Referring to claims 4 and 47, Kurokawa et al. disclose wherein said instructions for directing further comprise: Instructions for directing said first processing unit to: Receive a confirmation from said photographer responsive to said digital image being transmitted to said fulfillment center server (Step 49 of Fig. 2, page 2, paragraph 30).

Referring to claims 5 and 48, Kurokawa et al. disclose wherein said instructions for directing said first processing unit further comprise: Instructions for directing said first processing unit to: Determine said one of said at least one fulfillment centers to process said order from parameters received in said order (Step 45 of Fig. 2, page 2, paragraph 27) responsive to receiving said order (page 1, paragraph 19).

Referring to claims 6 and 49, Kurokawa et al. disclose wherein said instructions further comprise: Instructions for directing said first processing unit to: Receive a confirmation from said fulfillment center processing unit responsive to said order being processed (Step 48 of Fig. 2, page 2, paragraph 30).

Referring to claims 15 and 58, Kurokawa et al. disclose wherein said instructions to maintain said list of said at least one fulfillment centers comprises: Instructions for directing said processing unit to: Maintain a web page listing said at least one fulfillment centers (Fig. 4, page 2, paragraph 28) with hyper-link text pointing to web pages listing said options for said at least one fulfillment centers (Fig. 5, page 2, paragraph 28). The options include the selection of a print order reception shop.

Referring to claims 16 and 59, Kurokawa et al. disclose instructions for directing a photographer processing unit (terminal 4 of Fig. 1, page 2, paragraph 26) to: Establish a connection with said first processing unit (Print service receiving server, of Fig. 1, page 1, paragraph 19), Receive said list of said at least one fulfillment centers from said first processing unit (Fig. 4, page 2, paragraph 28), Receive said request for said list of options of said one of said at least one fulfillment centers (page 2, paragraph 23), Transmit said request to said first processing unit (Step 47 of Fig. 2, page 2, paragraph 28), Receive said list of options from said first processing unit, and Display said list of options to said photographer (page 2, paragraph 24); and A second media readable by said photographer processing unit that stores said instructions (page 2, paragraph 25). Garfinkle et al. disclose displaying a list of options for generating said photographic product (col. 8, lines 58-61).

Referring to claims 17 and 60, Kurokawa et al. disclose Instructions for directing said photographer processing unit to: Receive an input of said order (page 2, paragraph 24), and Transmit said order to said first processing unit (Step 47 of Fig. 2, page 2, paragraph 28).

Referring to claims 18 and 61, Kurokawa et al. disclose instructions for directing said photographer processing unit further comprise: Instructions for directing said photographer processing unit to: Receive said routing information from said first processing unit (Step 57 of Fig. 2, page 2, paragraph 27).

Referring to claims 19 and 62, Kurokawa et al. disclose instructions for directing said photographer processing unit to: instructions for directing said processing unit to: transmit said digital image to said first processing unit responsive to receiving said routing information (Step 47 of Fig. 2, page 2, paragraph 28).

Referring to claims 20 and 63, Kurokawa et al. disclose instructions for directing said photographer processing unit further comprises: Instructions for directing said photographer unit to: Transmit said digital image to said one of said at least one fulfillment center using said routing information responsive to receiving said routing information (Step 47 of Fig. 2, page 2, paragraph 28).

Referring to claims 21 and 64, Kurokawa et al. disclose transmitting a digital image but does not disclose expressly transmitting a confirmation to said first processing unit responsive to transmitting said digital image. It would have been obvious to transmit a confirmation after a transmission of data. When a transmission occurs between two computers, a handshake is used to initialize and commence

communication. The motivation for doing so would be to alert the receiving computer that no further data is to be expected for the transmission.

Referring to claims 22 and 65, Kurokawa et al. disclose instructions for directing said photographer processing unit further comprise: Instructions for directing said photographer unit to: Transmit an account identification to said first processing unit responsive to transmitting said order (page 2, paragraph 26).

Referring to claims 23 and 66, Kurokawa et al. disclose ordering digital images, but do not disclose expressly a graphic instruction set. Garfinkle et al. disclose wherein said order includes a graphic instruction set for said photograph (col. 5, lines 20-29). Kurokawa et al. and Garfinkle et al. are combinable because they are from the same field of ordering digital photographs. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to allow a graphic instruction set for a photograph. The motivation for doing so would have been to allow customization of a photograph to the particular desires of a customer. Therefore, it would have been obvious to combine Garfinkle et al. with Kurokawa et al. to obtain the invention as specified in claims 23 and 66.

Referring to claims 24 and 67, Kurokawa et al. disclose wherein said request includes parameters for selecting said one of said at least one fulfillment centers to process said order (Fig. 4, page 2, paragraph 28).

Referring to claims 25 and 68, Kurokawa et al. disclose ordering digital images, but do not disclose expressly selecting a fulfillment center based on location. Garfinkle et al. disclose wherein said parameters include a location of a fulfillment center (col. 9,

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lines 34-37). It would be obvious for a location to be a parameter for selecting a fulfillment center because Garfinkle et al. discloses the customer picking up the photographs at the fulfillment center. Kurokawa et al. and Garfinkle et al. are combinable because they are from the same field of ordering digital photographs. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to select a fulfillment center based on location. The motivation for doing so would have been to select the closest or easiest fulfillment center from which to pick up photographs. Therefore, it would have been obvious to combine Garfinkle et al. with Kurokawa et al. to obtain the invention as specified in claims 25 and 68.

Referring to claims 26 and 69, Kurokawa et al. disclose ordering digital images, but do not disclose expressly selecting a fulfillment center based on size. Garfinkle et al. disclose wherein said parameters include sizes for said photographic product (col. 8, lines 39-67). Garfinkle et al. further discloses that size can be specified for ordering prints (col. 5, lines 20-29). Kurokawa et al. and Garfinkle et al. are combinable because they are from the same field of ordering digital photographs. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to select a fulfillment center based on photo size. The motivation for doing so would have been to select a fulfillment center capable of providing photos in the desired size. Therefore, it would have been obvious to combine Garfinkle et al. with Kurokawa et al. to obtain the invention as specified in claims 26 and 69.

Referring to claims 27 and 70, Kurokawa et al. disclose ordering digital images, but do not disclose expressly selecting a fulfillment center based on graphics available.

Garfinkle et al. disclose wherein said parameters include graphics available for said photographic product (col. 5, lines 20-29). Kurokawa et al. and Garfinkle et al. are combinable because they are from the same field of ordering digital photographs. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to select a fulfillment center based graphics available. The motivation for doing so would have been to select a fulfillment center capable of providing photos in the desired format. Therefore, it would have been obvious to combine Garfinkle et al. with Kurokawa et al. to obtain the invention as specified in claims 27 and 70.

Referring to claims 28 and 71, Kurokawa et al. disclose ordering digital images, but do not disclose expressly selecting a fulfillment center based on price. Garfinkle et al. disclose wherein said parameters include a range of prices for said photographic product (col. 8, lines 52-61). Kurokawa et al. and Garfinkle et al. are combinable because they are from the same field of ordering digital photographs. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to select a fulfillment center based prices. The motivation for doing so would have been to select a fulfillment center with the least expensive prices. Therefore, it would have been obvious to combine Garfinkle et al. with Kurokawa et al. to obtain the invention as specified in claims 28 and 71.

Referring to claims 29 and 72, Kurokawa et al. disclose Instructions for directing a fulfillment center processing unit (service shop of Fig. 1, page 1, paragraph 19) to: Receive said order from said first processing unit (page 1, paragraph 19), Receive said digital image (Step 48 of Fig. 2, page 2, paragraph 30), and Process said order to

generate said photographic product (page 2, paragraph 21); and A media readable by said fulfillment center processing unit that stores said instructions. It is inherent that the service shop of Kurokawa et al. includes a memory that stores the performed instructions. RAM is an essential component for any computer and stores the instructions that are performed.

Referring to claims 30 and 73, Kurokawa et al. disclose instructions for directing said fulfillment center processing unit further comprising: Instructions for directing said processing unit to: Store said digital image to a memory (page 2, paragraph 21).

Referring to claims 31 and 74, Kurokawa et al. disclose storing digital images in memory for processing but do not disclose expressly deleting said digital image from memory responsive to processing said order. It would have been obvious to clear the memory after printing said images because the images would need to be stored on RAM for processing and RAM needs to consistently delete memory to provide space for future processing.

Referring to claims 32 and 75, Kurokawa et al. disclose storing digital images in memory but do not disclose expressly deleting the images. Garfinkle et al. disclose Instructions for directing said fulfillment center processing unit to: Delete said digital image from said memory responsive to a period of time being reached (col. 5, lines 40-44). Kurokawa et al. and Garfinkle et al. are combinable because they are from the same field of ordering digital photographs. At the time of the invention, it would have been obvious to a person of ordinary skill in the art delete images after a certain time period. The motivation for doing so would have been to free up the space on the server

for other images. Therefore, it would have been obvious to combine Garfinkle et al. with Kurokawa et al. to obtain the invention as specified in claims 32 and 75.

Referring to claims 34 and 77, Kurokawa et al. disclose instructions for directing said fulfillment center processing unit further comprising: Instructions for said fulfillment center processing unit to: Transmit an availability of said one of said at least one fulfillment centers to fulfill subsequent orders (page 2, paragraph 27).

Referring to claims 35 and 78, Kurokawa et al. disclose ordering digital images, but do not disclose expressly a graphic instruction set or generating a proof. Garfinkle et al. disclose generating a proof from said digital image and a graphic instruction set (col. 8, lines 13-19). Kurokawa et al. and Garfinkle et al. are combinable because they are from the same field of ordering digital photographs. At the time of the invention, it would have been obvious to a person of ordinary skill in the art generate a proof from a digital image and graphic instruction set. The motivation for doing so would have been to evaluate the images for errors before printing the order. Therefore, it would have been obvious to combine Garfinkle et al. with Kurokawa et al. to obtain the invention as specified in claims 35 and 78.

Referring to claims 36 and 79, Garfinkle et al. disclose instructions for directing said fulfillment center processing unit further comprises: Instructions for directing said fulfillment center processing unit to: Read said graphic instruction set from said order (col. 5, lines 20-29).

Referring to claims 37 and 80, Garfinkle et al. disclose instructions for directing said fulfillment center processing unit further comprises: Instructions for directing said

fulfillment center processing unit to: Receive said graphic instruction set from a photographer processing unit (col. 5, lines 20-29).

Referring to claims 38 and 81, Kurokawa et al. disclose instructions for directing said fulfillment processing unit further comprising: Instructions for directing said fulfillment center processing unit to: Receive said digital image from said first processing unit (page 2, paragraph 30).

Referring to claims 39 and 82, Kurokawa et al. disclose instructions for directing said fulfillment center processing unit to: Instructions for directing said fulfillment center processing unit to: Receive said digital image from a photographer processing unit (page 2, paragraph 30).

Referring to claims 40 and 83, Kurokawa et al. disclose wherein said list of options includes photographic product sizes (page 2, paragraph 23).

Referring to claims 43 and 86, Kurokawa et al. disclose wherein said list of options includes said at least one fulfillment centers that provide particular options (Fig. 4, page 2, paragraph 28).

Referring to claim 44, Kurokawa et al. disclose a method for generating a photographic product from a digital image comprising the steps of: Maintaining a list of at least one fulfillment centers available to generate said photographic product from said digital image (Fig. 4, page 2, paragraph 28) by a first processing unit (Print service receiving server, of Fig. 1, page 1, paragraph 19); Receiving a request from a photographer for a list of options to generate said photographic product from said digital image in said first processing unit (page 2, paragraph 23); Receiving an order from said

photographer (Step 48 of Fig. 2, page 2, paragraph 30) from said photographer processing unit (terminal 4 of Fig. 1, page 2, paragraph 26); Transmitting routing information to said photographer processing unit wherein said routing information is for transmitting said digital image to a one of said at least one fulfillment centers to process said order (page 2, paragraph 27); and Transmitting said order to a fulfillment center processing unit of said one of said at least one fulfillment centers (page 2, paragraph 29). Kurokawa et al. do not disclose expressly transmitting said list of options from a first processing unit to a photographer processing unit. Garfinkle et al. disclose transmitting said list of options for generating said photographic product from said first processing unit to a photographer processing unit (col. 8, lines 58-61). Kurokawa et al. and Garfinkle et al. are combinable because they are from the same field of ordering digital photographs. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to transmit the list of options for generating a photographic product from the server to the photographer. The motivation for doing so would have been to let the fulfillment centers update their products centrally opposed to storing the options on the terminal. Therefore, it would have been obvious to combine Garfinkle et al. with Kurokawa et al. to obtain the invention as specified in claim 44.

4. Claims 7, 33, 41, 42, 50, 76, 84, and 85 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kurokawa et al. Publication US 2001/0049640 and Garfinkle et

al. U.S. Patent 6,017,157 as applied to claims 1 and 44 above, and further in view of Jackson et al. U.S. Patent 6,760,128.

Referring to claims 7 and 50, Kurokawa et al. disclose charging a fee for photographic products but do not disclose expressly debiting an account. Jackson et al. disclose debiting a photographer account responsive to receiving said order (col. 4, lines 42-46). Kurokawa et al. and Jackson et al. are combinable because they are from the same field of ordering digital photographs. At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to keep an account for a photographer. The motivation for doing so would have been to have a system for billing a customer for goods provided. Therefore, it would have been obvious to combine Jackson et al. with Kurokawa et al. to obtain the invention as specified in claims 7 and 50.

Referring to claims 33 and 76, Kurokawa et al. disclose the fulfillment center processing unit and the first processing unit, but do not disclose expressly transmitting a status of the order periodically to the first processing unit. Jackson et al. disclose transmitting a status of said order periodically to said first processing unit (col. 9, lines 17-26). Kurokawa et al. and Jackson et al. are combinable because they are from the same field of ordering digital photographs. At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to periodically transmit the status of an order to a terminal. The motivation for doing so would have been to notify the customer when the order is completed. Therefore, it would have been obvious to

combine Jackson et al. with Kurokawa et al. to obtain the invention as specified in claims 7 and 50.

Referring to claims 41 and 84, Kurokawa et al. disclose a list of options but do not disclose expressly selecting a type of paper. Jackson et al. disclose a list of options includes types of paper available for said photographic product (col. 7, lines 11-13). Kurokawa et al. and Jackson et al. are combinable because they are from the same field of ordering digital photographs. At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to allow the customer to select a type of paper to print digital photos on. The motivation for doing so would have been to allow the customer to select a particular paper type according to a customer's preference. Therefore, it would have been obvious to combine Jackson et al. with Kurokawa et al. to obtain the invention as specified in claims 41 and 84.

Referring to claims 42 and 85, Kurokawa et al. disclose a list of options but do not disclose expressly graphics available to add to the image. Jackson et al. disclose a list of options includes graphics available to add to said digital image to generate said photographic product (col. 7, lines 13-15). Kurokawa et al. and Jackson et al. are combinable because they are from the same field of ordering digital photographs. At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to allow the customer to insert a graphic into a photograph. The motivation for doing so would have been to allow the customer to insert a date into a photograph. Therefore, it would have been obvious to combine Jackson et al. with Kurokawa et al. to obtain the invention as specified in claims 42 and 85.

5. Claims 8-11, and 51-54 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kurokawa et al. Publication US 2001/0049640, Garfinkle et al. U.S. Patent 6,017,157 and Jackson et al. U.S. Patent 6,760,128 as applied to claims 7 and 50 above, and further in view of Norris U.S. Patent 6,105,007.

Referring to claims 8 and 51, Jackson et al. disclose an account but do not disclose expressly receiving funds and crediting said account. Norris discloses receive a transfer of funds, and credit said funds to said account responsive receiving said funds are received (col. 14, lines 5-11). Norris and Kurokawa et al. are combinable because they are from the same field of money charging computer systems. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to transfer funds and credit an account. The motivation for doing so would have been to provide a means to deposit money into an account. Therefore, it would have been obvious to combine Norris with Kurokawa et al. to obtain the invention as specified in claims 8 and 51.

Referring to claims 9 and 52, Norris discloses wherein said funds are transferred electronically (col. 2, lines 62-65).

Referring to claims 10 and 53, Garfinkle et al. disclose wherein said instructions for transmitting said order to said fulfillment center processing unit are executed responsive to receiving said funds (5n and 5o of Fig. 5E, col. 9, lines 26-33). Kurokawa et al. and Garfinkle et al. are combinable because they are from the same field of ordering digital photographs. At the time of the invention, it would have been obvious to

a person of ordinary skill in the art receive funds before sending an order to a fulfillment center. The motivation for doing so would have been to verify a customer has the required money before performing a service. Therefore, it would have been obvious to combine Garfinkle et al. with Kurokawa et al. to obtain the invention as specified in claims 10 and 53.

Referring to claims 11 and 54, Jackson et al. disclose wherein said instructions further comprise: Instructions for directing said first processing unit to: credit said funds received from said photographer to an account of said one of said at least one fulfillment centers responsive to receiving said funds (col. 14, lines 5-11).

6. Claims 12-14 and 55-57 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kurokawa et al. Publication US 2001/0049640 and Garfinkle et al. U.S. Patent 6,017,157 as applied to claims 1 and 44 above, and further in view of Marwell et al. U.S. Patent 6,404,884.

Referring to claims 12 and 55, Kurokawa et al. disclose a service charge but do not disclose expressly charging periodically. Marwell et al. disclose periodically debiting a service charge to said account (col. 14, lines 45-49). Kurokawa et al. and Marwell et al. are combinable because they are from the same field of charging money for provided services. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to periodically charge a fee. The motivation for doing so would have been to deduct a monthly fee for unlimited use of the system. Therefore, it would

have been obvious to combine Marwell et al. with Kurokawa et al. to obtain the invention as specified in claims 12 and 55.

Referring to claims 13 and 56, Kurokawa et al. disclose maintaining a count of a number of orders (number of prints, page 2, paragraph 23).

Referring to claims 14 and 57, Marwell et al. disclose debiting a transactional charge for said order responsive to said count being above a predetermined number (col. 14, lines 45-49). The predetermined number disclosed by Marwell et al. is 1.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter K. Huntsinger whose telephone number is (571)272-7435. The examiner can normally be reached on Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Moore can be reached on (571)272-7437. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
**KING Y. POON**  
**PRIMARY EXAMINER**

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